

C. APPLICANT'S COMMENTS

Claims 10-17, 19 are pending in this Application, with Claims 10, 16 being amended, Claims 1-9, 18 and 20 being canceled and Claims 21-26 being added. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 10-17, 19 and favorable consideration of Claims 21-26 is respectfully requested. The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 1 of the Office Action

The Applicant has canceled Claims 1-9 and 20 which were previously withdrawn by the Applicant.

Paragraph 2 of the Office Action

The Applicant has canceled Claim 18.

Paragraph 3 of the Office Action

The Office Action rejected as-filed Claims 10-19 under 35 U.S.C. §102(b) as being anticipated by Hall (U.S. Patent No. 4,630,771). The Office Action stated that “[i]n claim 10, ‘upon at least one electronic device’ and ‘towards at least one electronic device’ are seen as intended use and functional language, respectively.” (Office Action, Page 2.) The Office Action further stated that “[t]he device of Hall is inherently capable of spraying an electronic device, so the intended use and the functional language is seen as being met by the structure of Hall.” (Office Action, Page 2.)

“Inherency” requires inevitably. Thus, to be “inherent” the alleged result must be inevitable from the operation disclosed or the inherent characteristic must be inevitably present in the device. *Akamai Technologies, Inc. v. Cable & Wireless Internet Services, Inc.*, 344 F.3d 1186, 1192 (Fed. Cir. 2003) (“A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present.”) Hall merely teaches an

“economical fountainhead” that simply creates a “multi-tier fountain” having “different tier heights.” (Column 1, Lines 5-8.) There is nothing in Hall that discloses an operation that would result in the inevitable result of “spraying an electronic device.” Also, there is no inherent characteristic in the device shown in Hall that is inevitably present relating to the “spraying an electronic device.” Furthermore, Hall does not even teach that the “spraying an electronic device” is probably or even possibly present – even if this were true it would not satisfy the legal requirements of inherency. *Id.*

The Applicant has amended independent Claims 10, 16 to further clarify the claimed subject matter, though this is not required in view that Hall does not inherently teach the claimed characteristics of the claims. The Applicant respectfully submits that Hall does not teach the limitations of the claims and therefore requests that the rejection under 35 U.S.C. §102(b) be withdrawn. In addition, Hall is non-analogous to the present invention and therefore should not be considered under 35 U.S.C. §103(a).

Paragraph 4 of the Office Action

The Office Action rejected as-filed Claims 10-19 under 35 U.S.C. §102(b) as being anticipated by Malmquist (U.S. Patent No. 189,368). The Office Action stated that “[i]n claim 10, ‘upon at least one electronic device’ and ‘towards at least one electronic device’ are seen as intended use and functional language, respectively.” (Office Action, Page 3.) The Office Action further stated that “[t]he device of Malmquist is inherently capable of spraying an electronic device, so the intended use and the functional language is seen as being met by the structure of Malmquist.” (Office Action, Page 3.)

As stated above, “inherency” requires inevitably. Thus, to be “inherent” the alleged result must be inevitable from the operation disclosed or the inherent characteristic must be inevitably present in the device. *Akamai Technologies, Inc.*, 344 F.3d at 1192. Malmquist merely teaches an “combined nozzle and sprinkler” that is attached to a hose “to throw a solid stream or a shower” for watering plants and the like. (Page 1.) There is nothing in Malmquist that discloses an operation that would result in the inevitable result of “spraying an electronic device.” Also,

there is no inherent characteristic in the device shown in Malmquist that is inevitably present relating to the “spraying an electronic device.” Furthermore, Malmquist does not even teach that the “spraying an electronic device” is probably or even possibly present – even if this were true it would not satisfy the legal requirements of inherency. *Id.*

The Applicant has amended independent Claims 10, 16 to further clarify the claimed subject matter, though this is not required in view that Malmquist does not inherently teach the claimed characteristics of the claims. The Applicant respectfully submits that Malmquist does not teach the limitations of the claims and therefore requests that the rejection under 35 U.S.C. §102(b) be withdrawn. In addition, Malmquist is non-analogous to the present invention and therefore should not be considered under 35 U.S.C. §103(a).

Paragraph 5 of the Office Action

The Office Action rejected as-filed Claims 10-19 under 35 U.S.C. §102(b) as being anticipated by Hawks (U.S. Patent No. 549,359), Thomson (U.S. Patent No. 166,654) or Wentworth (U.S. Patent No. 151,735) (collectively referred to as the “Hose Pipe Nozzle Patents”. The Office Action stated that “[i]n claim 10, ‘upon at least one electronic device’ and ‘towards at least one electronic device’ are seen as intended use and functional language, respectively.” (Office Action, Page 3.) The Office Action further stated that “[t]he device of any of the three above references is inherently capable of spraying an electronic device, so the intended use and the functional language is seen as being met by the structure of the references.” (Office Action, Pages 3-4.)

As stated above, “inherency” requires inevitably. Thus, to be “inherent” the alleged result must be inevitable from the operation disclosed or the inherent characteristic must be inevitably present in the device. *Akamai Technologies, Inc.*, 344 F.3d at 1192. The Hose Pipe Nozzle Patents merely teach “hose-nozzles” that attach to the end of a garden hose for watering plants and the like. There is nothing in any of the Hose Pipe Nozzle Patents that discloses an operation that would result in the inevitable result of “spraying an electronic device.” Also, there is no inherent characteristic in the devices shown in either of the Hose Pipe Nozzle Patents that is

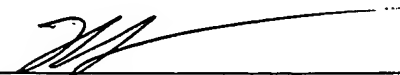
inevitably present relating to the “spraying an electronic device.” Furthermore, the Hose Pipe Nozzle Patents do not even teach that the “spraying an electronic device” is probably or even possibly present – even if this were true it would not satisfy the legal requirements of inherency. *Id.*

The Applicant has amended independent Claims 10, 16 to further clarify the claimed subject matter, though this is not required in view that the Hose Pipe Nozzle Patents do not inherently teach the claimed characteristics of the claims. The Applicant respectfully submits that the Hose Pipe Nozzle Patents do not teach the limitations of the claims and therefore requests that the rejection under 35 U.S.C. §102(b) be withdrawn. In addition, the Hose Pipe Nozzle Patents are non-analogous to the present invention and therefore should not be considered under 35 U.S.C. §103(a).

D. CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner’s Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,



Michael S. Neustel (Reg. No. 41,221)
NEUSTEL LAW OFFICES, Ltd.
2534 South University Drive, Suite No. 4
Fargo, North Dakota 58103

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Date

Telephone: (701) 281-8822
Facsimile: (701) 237-0544
e-mail: Michael@neustel.com